REMARKS

Claims 1-49 remain in the application for further prosecution. Claims 1-11, 16-31, and

36-49 have been rejected. Claims 12-15 and 32-35 were indicated as including patentable

subject matter.

I.   35 U.S.C. § 102 REJECTION

Claims 1-11, 16-31, and 36-49 have been rejected under 35 U.S.C. 102(a) as being

anticipated by Nicastro, SR (U.S. 2003/0027619 A1)("Nicastro"). This rejection is traversed.

Reconsideration and withdrawal of this rejection is requested.

Independent claim 1 and claims 2-11 and 16-18 depending therefrom recite a method of

conducting a game on a gaming machine, the gaming machine including a controller having a

processor and a memory, the method comprising the act of displaying the game on a video

display of the gaming machine, the game including a displayed grid and a plurality of displayed

video reels, the displayed grid having a plurality of rows, each of the plurality of rows having a

plurality of tiles. The method also includes the acts of enabling a first player selection of a first

tile from a first row of the displayed grid, detecting the first player selection of the first tile from

the first row, and, in response to the first player selection, causing the plurality of video reels to

spin and stop to display a first outcome, and causing a first action associated with the first player

selection. The further includes awarding a first award to the player based on the first outcome.

The Examiner alleges that Nicastro discloses a method of conducting a game on a gaming

machine comprising displaying the game on a video display of the gaming machine (*citing* Fig.

1, 16), the game including a displayed grid and a plurality of displayed video reels (*citing* Figs.

1-6), the displayed grid having a plurality of rows, each of the plurality of rows having a

plurality of tiles (*citing* Fig. 6). Nicastro is also said to include the acts of enabling a first player

selection of a first tile from a first row of a displayed grid (*citing* page 4, [0052]), detecting the

first player selection of the first tile from the first row (*citing* Fig. 6), and, in response to the first

player selection, causing the plurality of video reels to spin and stop to display a first outcome

(*citing* Fig. 6), and causing a first action associated with the first player selection. Nicastro is

further alleged to disclose awarding a first award to the player based on the first outcome (*citing*

page 7, [0070], Figs. 12-14).

Paragraph [0052], cited by the Examiner, discloses that FIG. 6 shows a game screen of a

bonus game for a gaming machine in the middle of the bonus game. In FIG. 6, the player has

selected and taken first tile 130 having a tile value of 225 and second tile 132 having a tile value

of 450. The player selected third tile 134 having a tile value of 90, but left it in hopes of selecting

a tile having a larger tile value, as indicated by the LEAVE IT legend on the tile. The player also

selected fourth tile 136 having a stopper value, but left it so that they could continue with the

bonus game, as indicated by the LEAVE IT legend on the tile. The Take It window 114 value of

ten shows that the player can take ten more tiles. The Leave It window 110 value of one shows

that the player can leave one more selected tile with a numerical value or a stopper value. In the

bonus game of FIG. 6, the player can continue until the player selects and takes ten tiles, leaves

one tile and selects and takes tiles until selecting a tile with a stopper value, or selects a tile with

a stopper value and mistakenly takes it.

Significantly, Nicastro does <u>not</u> disclose (or suggest) detecting the first player selection

of the first tile from the first row, and, in response to the first player selection, causing the

plurality of video reels to spin and stop to display a first outcome, awarding a first award to the

player based on the first outcome, and causing a first action associated with the first player

selection, as recited. Instead, Nicastro, FIG. 6, and paragraph [0052] related thereto, while

disclosing the selection of a tile 122 in a bonus game, fails to disclose or suggest, in response to

such selection, causing "the plurality of video reels to spin and stop to display a first outcome" or

"awarding a first award to the player based on the first outcome." The basic game of Nicastro

does include reels (*see, e.g.*, FIGS. 1-2, par. [0032]). However, the reel-based game of Nicastro

(*e.g.*, the basic game in FIGS. 2-3) is disconnected from the tile-picking game of FIGS. 4-6 (*e.g.*,

the bonus game), save for a triggering event in the reel-based game (*e.g.*, "three or more bonus

symbols on adjacent reels along a pay line," par. [0047]) that causes entry into the tile-picking

game. When the triggering event is obtained, the basic game is terminated, a transition screen 80

is displayed, and the game machine then initiates play of a separate bonus game by displaying a

bonus game screen 84. When the bonus game concludes, the player is awarded an award

corresponding to the amount in the total window 116 and points won window 118. This

terminates the bonus game and the player has the option of starting a new wagering game.

Nicastro does <u>not</u>, for example, detect the first player selection of a tile 122, and, in response to

the first player selection, cause a plurality of video reels to spin and stop to display a first

outcome. In Nicastro, these elements are wholly divorced from one another.

It is noted that the Examiner stated in the rejection that Nicastro discloses, in relation to

FIG. 6, "in response to the first player selection, causing the plurality of video reels to spin and

stop to display a first outcome" (*see* page 2 of Office Action, numbered paragraph 3). This

statement is respectfully submitted to be in error. FIG. 6 of Nicastro <u>does not</u> disclose video reel,

nor does it show or suggest causing the plurality of video reels to spin and stop to display a first

outcome. Instead, FIG. 6 of Nicastro shows only selectable tiles in a picking bonus game.

The Examiner also cites, as to claims 5-9 and 16-18, Nicastro FIGS. 10-12, which show,

in paragraphs [0062]-[0071], a transition screen to a bonus game and a bonus game comprising a

tile area 502 containing a game area 508 in which a plurality of selectable tiles are disposed. Similar to FIG. 6, the player is permitted to select a tile, upon which selection, the outcome associated with the selected tile is revealed to the player (*see* par. [0067]). Further to the above and in regard to the particular limitations of claims 5-9 and 16-18, Applicant respectfully submits that Nicastro has not been shown to identically disclose a "first tile comprises a trap tile," as recited by claims 5-7. Nicastro discloses that the game field of FIGS. 10-12 includes "a starting position 514, a plurality of mouse holes 516, bridges 518, and an ending position 520" (par. 0063]). Nicastro does not identically disclose a "trap tile." Instead, Nicastro notes that in an aspect wherein a player "mistakenly selects the mouse hole 516 connected to the occupied mouse hole 516 (identified by the mouse token 524) by a single bridge and not connected to any other mouse hole 516, the bridge 518 will disappear after the player crosses and the player will be trapped with no further movement possible" (*see* par. [0069]). This is not identical to the recited trap tile. Moreover, as to claims 6 and 7, the "trapping" disclosed by Nicastro is, by Nicastro's definition, a game ending outcome regardless of the presence of any mouse tokens in the mouse token window 506. In contrast, claim 6 recites that, further to the recited method of claim 5, the first action comprises "deleting a token from the plurality of displayed tokens" and "enabling a second player selection of a second tile from a second row of the grid if at least one row remains of the grid" and claim 7 recites that, further to the recited method of claim 5, the first action comprises "causing the game to end if no token is displayed on the video display" and "causing the first credit amount to be added to a credit meter of the gaming machine." Thus, Nicastro fails to identically teach (or suggest) the subject matter recited in claims 5-7.

Still further, as to the subject matter of dependent claims 8-9, Nicastro fails to identically disclose or suggest that the game field 508 comprises "a token tile," as recited by claim 8, or

wherein the first action comprises, further to claim 8, "adding a token to the plurality of displayed tokens" and "enabling a second player selection of a second tile from a second row of the grid if at least one row remains of the grid." Nicastro shows no token tiles nor does Nicastro include any provision for, during the bonus game, increasing the number of tokens (*e.g.*, mouse tokens).

Still further, Nicastro fails to disclose or suggest acts comprising "enabling a last player selection of a last tile from a last row of the grid," "detecting the last player selection of the last tile from the last row," "in response to the last player selection, causing the video reels to spin and stop to display a last outcome, and enabling a secondary bonus game having a guaranteed award if the last tile is not a trap tile," and "awarding a last credit amount to the player based on the last outcome" (claims 16-17) or the acts comprising "enabling a last player selection of a last tile from a last row of the grid," "detecting the last player selection of the last tile from the last row," "in response to the last player selection, causing the video reels to spin and stop to display a last outcome, and enabling a secondary bonus game having a guaranteed award if the last tile is a trap tile and at least one token is displayed on the video display," and "awarding a last credit amount to the player based on the last outcome" (claim 18). For example, further to the above noted deficiencies of Nicastro, Applicant notes that the Examiner cites FIG. 12 in support of the assertion that Nicastro allegedly discloses "enabling a secondary bonus game having a guaranteed award if the last tile is not a trap tile" (*see* page 3 of Office Action). However, FIG. 12 merely depicts an end game screen for a game ending when the mouse is trapped and no further moves are possible (*see* par. [0070]). This is not identical to the recited trap tile. Further, Nicastro does not appear to disclose or suggest, nor has Nicastro been shown to disclose or suggest, "enabling a secondary bonus game having a guaranteed award."

For at least the above reasons, it is respectfully submitted that a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been made over the rejection of claims 1-11 and 16-18 and that Nicastro fails to identically teach each and every element of claims 1-11 and 16-18. Reconsideration and withdrawal of this rejection is requested.

Similar deficiencies to those noted above exist in relation to Nicastro and independent claim 19 and claims 20-39 depending therefrom and independent claim 40 and claims 41-49 depending therefrom. Claim 19, for example, recites the acts of displaying the game on a video display of the gaming machine, the game including a plurality of player selections and a plurality of game play images; detecting a first player selection by a player from among the plurality of player selections; and, in response to the first player selection, causing the plurality of game play images to display a first outcome, and causing a first action associated with the first player selection. Claim 19 further recites awarding a first award to the player based on the first outcome. Nicastro fails to teach or suggest, for example, detecting a first player selection by a player from among the plurality of player selections and, in response to the first player selection, causing the plurality of game play images to display a first outcome, and causing a first action associated with the first player selection. FIG. 6 of Nicastro, cited repeatedly by the Examiner, teaches that, in response to a player selection of a tile 122, an outcome associated with the tile is revealed. For example, the player selection of a first tile 130 reveals a tile value of 225. Nicastro fails to disclose or suggest displaying the game on a video display of the gaming machine, the game including (1) *a plurality of player selections* and (2) a plurality of *game play images* and, responsive to a player's selection, causing the plurality of *game play images* to display a first outcome, and causing a first action associated with the first player selection. As noted above, FIG. 6 of Nicastro shows, for example, a player selection of a first tile 130, which

itself reveals a tile value of 225. Thus, the player selectable element in Nicastro (*i.e.*, the tiles 122) itself displays the outcome of the selection. In Nicastro, a game play image different than the player selectable tile is not used to display a first outcome, nor is a separate action associated with the player selection.

Further, for the reasons noted above with regard to dependent claims 8-9 and 16-18, for example, Applicant respectfully submits that Nicastro fails to identically disclose (or suggest) the subject matter recited in any of dependent claims 20-39, such remarks being incorporated herein, but otherwise being omitted for brevity.

For at least the above reasons, it is respectfully submitted that a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been made over the rejection of claims 19-39 and that Nicastro fails to identically teach each and every element of claims 19-39. Reconsideration and withdrawal of this rejection is requested.

Claim 40 similarly recites a gaming machine comprising a controller programmed to display a game on the video display device, the game including a plurality of player selections and a plurality of game play images, detect a player selection by a player from among the plurality of player selections and, responsive to a player selection, cause the plurality of game play images to display an outcome, and cause an action associated with the player selection, the controller also being programmed to award a credit amount to the player based on the outcome.

As noted above, Nicastro fails to teach or suggest, for example, detecting a first player selection by a player from among the plurality of player selections and, responsive to the first player selection, causing the plurality of game play images to display an outcome, and causing an action associated with the player selection. Nicastro, FIG. 6, teaches that, in response to a player selection of a tile 122, an outcome associated with the tile is revealed. Nicastro fails to

disclose or suggest displaying the game on a video display of the gaming machine, the game

including (1) *a plurality of player selections* and (2) a plurality of *game play images* and,

responsive to a player's selection, causing the plurality of *game play images* to display an

outcome, and causing an action associated with the player selection. As noted above, FIG. 6 of

Nicastro shows, for example, a player selection of a tile 130, which itself reveals a tile value of

225. Thus, the player selectable element in Nicastro (i.e., the tiles 122) itself displays the

outcome of the selection. In Nicastro, a game play image different than the player selectable tile

is <u>not</u> used to display an outcome, nor is a separate action associated with the player selection.

Further, for the reasons noted above with regard to dependent claims 8-9 and 16-18, for

example, Applicant respectfully submits that Nicastro fails to identically disclose (or suggest) the

subject matter recited in any of dependent claims 41-49, such remarks being incorporated herein,

but otherwise being omitted for brevity.

For at least the above reasons, it is respectfully submitted that a *prima facie* case of

anticipation under 35 U.S.C. § 102 has not been made over the rejection of claims 40-49 and that

Nicastro fails to identically teach each and every element of claims 40-49. Reconsideration and

withdrawal of this rejection is requested.

Accordingly, reconsideration and withdrawal of the imposed 35 U.S.C. § 102 rejection is

respectfully requested.

II.   ALLOWABLE SUBJECT MATTER

Claims 12-15 and 32-25 were objected to as being dependent upon a rejected base claim,

but were indicated to contain allowable subject matter and would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectively submits that the present claims are patentable over the art of record and are in condition for allowance as the Examiner has no doubt cited the best references at his command in accord with C.F.R. § 1.104(c) and set forth rejections including all valid grounds available in accord with MPEP § 707.07(g)). Accordingly, it is Applicant's belief that all of the claims are patentable and are in condition for allowance and that claims 12-15 and 32-35 are allowable as presently presented and need not be amended in independent form.

III. CONCLUSION

The Applicant believes the claims are in condition for allowance, and action towards that end is earnestly solicited.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Although no fees are believed due in connection with this amendment, the Commissioner is authorized to deduct any necessary fees (except for payment of the issue fee), from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000262USPT.

Respectfully submitted,

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